

Remarks

Claim Status:

Claims 1-16 are pending. Dependent claims 14-16 are newly presented.

Art-based Rejection:

Claim 1 is rejected as being anticipated by Daly-819. Claims 2-5 are rejected as being unpatentable over Daly-819 in view of Lawler. Claims 8-13 are apparently rejected under the reasons set forth for claims 4 and 5. *Please see* the Office Action, page 6, lines 1-2. Claims 6 and 7 are rejected as being unpatentable over Daly-819 in view of Cass.

We respectfully traverse these rejections.

Claim 8

Claim recites – in combination with other features – altering color values of an image by an amount to achieve change values, the amount includes a compensation for a variation in a relationship of an input color value and at least one of ink and dye provided by a printing process to represent the input color value.

The Office Action states that the combination recited in claim 8 is rejected as set forth in claims 4 and 5. *Please see* the Office Action on page 5, lines 10-11.

But we do not see this set of features expressly set forth in claims 4 or 5.

Thus, this rejection seems to cut against the guidance provided by the MPEP (see, e.g., MPEP 706.02(j)). For example: “[T]he examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate....”

See MPEP 706.02(j).

This is because “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” See MPEP 706.02(j).

Since each of the features of claim 8 has not been discussed on the record, the Applicant is left to guess as to the intended rejection relative to claims 4 and 5. And “guessing” denies the Applicant a fair opportunity to reply on the record.

(We note that the Office Action on page 3 states that the references teach various features of claim 8. Yet, despite this assertion, no passages are cited to in the Office Action. This is contrary to the counsel given in MPEP 706.02(j).)

Moreover, we do not understand the applied references to render obvious the recited combination.

Claim 8 should be allowed.

Claim 12

Claim 12 recites – in combination with other features of the claim – receiving a representation of a variation in a relationship of an input color value and at least one of ink and dye provided by the printing process to represent the input color value.

Like claim 8 above, the Office Action states that the combination recited in claim 12 is rejected as set forth in claims 4 and 5. *Please see* the Office Action on page 6, lines 1-2.

But we do not see this set of features expressly set forth in claims 4 or 5.

Again, Applicant is again denied a fair opportunity to respond on the record to this rejection. As such, the rejection should be removed.

(We note that the Office Action on page 3 states that the references teach various features of claim 12. Yet, despite this assertion, no passages are cited to in the Office Action. This is contrary to the counsel given in MPEP 706.02(j).)

Claim 12 stands ready for allowance.

Claim 1

Claim 1 recites adjusting the image in accordance with values in a first representation utilized by a printing process; determining values to convey a digital watermark in the adjusted image; adjusting the values in accordance with a second representation utilized by the printing process; and combining the adjusted change values and the image to produce a digital watermarked image.

The Office Action recognizes Daly's deficiencies and cites Lawler as showing a first (i.e., fig 6) and second (i.e., fig. 7) representations being utilized by a printing process.

We respectfully disagree with this analysis.

For example, the different Lawler representations do not – respectively – adjust an image (fig. 6) and adjust values to convey a digital watermark (fig. 7) as would be required by claim 1. So even if combined as suggested, the resulting combination would not yield the recited combination.

Claim 1 stands ready for allowance.

Remaining Claims

We respectfully request reconsideration of the remaining dependent claims as well.

Conclusion:

We respectfully request a Notice of Allowance. In the meantime, the Examiner is respectfully invited to contact the undersigned with any questions.

Date: October 18, 2007

Customer No. 23735

Phone: 503-469-4685

FAX 503-469-4777

Respectfully submitted,

DIGIMARC CORPORATION

By: /Steven W. Stewart, Reg. No. 45,133/
Steven W. Stewart
Registration No. 45,133